



14/Response
6/13/03
HJ

In re Patent Application of
Hongyong ZHANG et al.
Serial No. 09/712,286
Filed: November 15, 2000
For: OPTICAL SENSOR

) Art Unit: 2811
) Examiner: Gene M. Munson
)
)
)
)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with
The United States Postal Service with sufficient postage as First
Class Mail in an envelope addressed to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450, on June 9, 2003.

Robert M. Stamps

RECEIVED
JUN 12 2003
TECHNOLOGY CENTER 2800

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Official Action mailed March 7, 2003 has been received and its contents carefully noted. This response is filed within 3 months of the mailing date of this Official Action. Accordingly, Applicant respectfully submits that this response is being timely filed.

Applicant notes with appreciation the consideration of the Information Disclosure Statement filed on November 15, 2000.

Claims 1-4, 6-9, and 21-63 are now pending in the present application, of which claims 1, 6, 21, 28, 35, 42, 49, 56, and 60 are independent. Claims 21-55 have been withdrawn from consideration. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

The Official Action rejects claims 1, 2, 4, 6, 7, 9, 56, 57, 59-61, and 63 as anticipated by U.S. Patent 5,216,491 to Yamamoto. It is well established that "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Official Action asserts that the bias terminal and ground potential recited in independent claims 1, 6, 56 and 60 read on terminal VB in Figure 3 of Yamamoto. However, as recited in these claims and shown in at least Figure 3 of the subject application, the bias terminal and ground potential are different and independent elements. Yamamoto fails to disclose the second electrode of the capacitor at a ground potential, and the second electrode of the optical sensor being electrically connected to a bias terminal as recited in the pending claims. Since the prior art fails to disclose each and every element recited in the claims, the claims are not anticipated by Yamamoto and reconsideration is requested.

The Official Action next rejects claims 3, 8, 58, and 62 as obvious based on the combination of Yamamoto and U.S. Patent 4,549,088 to Ozawa. It is respectfully submitted that Ozawa does nothing to overcome the deficiencies noted above in connection with Yamamoto and that claims 3, 8, 58, and 62 are allowable for the same reasons as noted above. Reconsideration is requested.

The Official Action next rejects claims 1-4 and 56-59 as anticipated by U.S. Patent 4,862,237 to Morozumi. The Official Action asserts that the bias terminal and ground potential read on a terminal in Figures 3 and 12 that corresponds to a ground terminal in Figure 1. As noted above, however, it is again respectfully asserted that the bias terminal and ground potential of the present invention are different and independent elements. Morozumi fails to disclose the second electrode of the capacitor at a ground potential, and the second electrode of the optical sensor being electrically connected to a bias terminal. Since the prior art fails to disclose each and every element recited in the claims, the claims are not anticipated by Morozumi and reconsideration is requested.

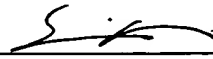
The Official Action next rejects claims 1-4 and 56-59 as obvious based on Morozumi. The Official Action asserts that it would have been obvious to provide a bias terminal in a device as in Morozumi in order to provide a ground potential as in Figure 1.

As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

It is respectfully submitted that Morozumi fails to disclose or suggest all the claim limitations recited in the pending claims and that there has been an insufficient showing that one of skill in the art would have been motivated to modify Morozumi to achieve the present invention. Morozumi fails to disclose the second electrode of the capacitor at a ground potential, and the second electrode of the optical sensor being electrically connected to a bias terminal and it is respectfully submitted that one of skill in the art would not have been motivated to modify Morozumi to achieve the present invention. Since the prior art fails to disclose or suggest each and every element of the subject invention and since there has been an insufficient showing that one of skill in the art would have been motivated to modify Morozumi, a *prima facie* case of obviousness cannot be maintained and favorable reconsideration is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789